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Yoshikazu Kobayashi

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WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

EXAMINER

SCHEIBEL, ROBERT C

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/738,981	Applicant(s) KOBAYASHI, YOSHIKAZU	
	Examiner Robert C. Scheibel	Art Unit 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005 and 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,6-10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action acknowledges Applicant's Amendment filed 9/23/2005 and Applicant's Supplemental Amendment filed 11/14/2005.
- Claims 1 and 10 have been amended with Applicant's Amendment filed 9/23/2005.
- Claims 12-14 have been added with Applicant's Supplemental Amendment filed 11/14/2005.
- Claims 1, 3, 6-10, and 12-14 are currently pending.

Response to Arguments

1. Applicant's arguments, see paragraph 3 on page 5, filed 9/23/2005, with respect to the rejection of claims 1 and 10 under 35 U.S.C. 112, second paragraph, have been fully considered and are persuasive. The rejection of claims 1 and 10 under 35 U.S.C. 112, second paragraph, has been withdrawn.
2. Applicant's arguments, see pages 5-11, filed 9/23/2005, with respect to the rejection of claims 1-3 and 6-10 under 35 U.S.C. 103(a), have been fully considered but they are not persuasive.

In the fourth paragraph on page 5, Applicant summarizes the arguments regarding the rejection under 35 U.S.C. 103(a). In the next paragraph, Applicant describes the general problem being solved by the present invention. In the following paragraph, Applicant generally describes the invention's solution to this problem. In the first paragraph of page 7 and the following paragraph, Applicant summarizes some of the features of the Galvin reference used in the rejection under 35 U.S.C. 103(a). On page 8, Applicant recites portions of the previous

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office action. Specifically, Applicant restates the claim limitations that are not expressly disclosed by Galvin. Applicant states that Galvin does not suggest the missing features. Examiner disagrees with this assertion as Galvin indicates that figures 2-4 merely provide one example for the organization of this information and that “many variations and permutations of the organization of the information used by the present invention will be readily apparent to one having ordinary skill in the art” (Galvin, column 7, lines 51-54). As further evidence of this, Galvin (in lines 14-17 of column 6) indicates that one or more databases may be used to store this information. It is apparent that the example of figures 2-4 uses multiple databases or tables and that one of the alternatives is one database or table as suggested in this passage.

In the first paragraph of page 9, Applicant argues that Galvin does not disclose sequences of a terminal and main apparatus and frames in which a nickname is automatically generated. However, there is nothing in the claim language containing this feature. In the next two paragraphs, Applicant states that since Galvin cannot provide a service with simple installation, the present invention is not disclosed. However, whether this is true of Galvin or not, there is nothing in the claim language including the feature of simple installation. Similarly, the next paragraph states that with the present invention, an engineer can install the IP phone if he knows the extension number of the telephone and its installation place. Again, this limitation is not in the claim language.

The last paragraph on page 9 describes the RFC 1531 reference. Then, in the first full paragraph on page 10, Applicant asserts that the RFC does not disclose the address allocating circuit. However, as stated in the previous office action, this is disclosed throughout the document; the action cited the abstract as one example. Specifically, the abstract states that

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DHCP adds “the capability of automatic allocation of reusable network addresses”. It is clear that this functionality can be added through either a circuit or software on the device implementing this protocol and thus, the address allocating circuit is clearly disclosed in RFC 1531. Applicant further argues that there must be sufficient motivation to combine these references outside of Applicant’s own disclosure. Examiner notes that the previous office action cited the first paragraph of page 7 of RFC 1531 as providing clear motivation of allowing hosts to discover local configuration information without manual configuration. Examiner maintains that this provides sufficient motivation to combine these two references. DHCP is well known in the art as a means of automatically generating IP addresses. The remaining paragraphs of this section restate the limitations of claims 1 and 10, emphasizing certain limitations.

3. Applicant’s arguments, see pages 6-7, filed 11/14/2005, with respect to the rejection of claims 1-3 and 6-10 under 35 U.S.C. 103(a), have been fully considered but they are not persuasive.

In the second, third, and fourth paragraphs of page 6, Applicant describes the invention in general terms. Some of the limitations discussed in these paragraphs are claimed, while others are not. In the next paragraph, Applicant describes parts of the Galvin reference and then states that it does not describe a sequence between a terminal and a main apparatus for automatically generating a nickname. However, there is nothing in the claim language containing this feature.

Claim Objections

4. Claim 12 is objected to because of the following informalities: the phrase “includes identification data a global domain name” on lines 10-11 does not make sense as written.

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Examiner believes that this should be corrected to “includes identification data *and* a global domain name”. Appropriate correction is required.

5. Claims **13 and 14** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Specifically, both claims broaden the independent claim by replacing the ID (“in place of said ID”) of the registration request message with a user identification section (claim 13) or an extension telephone number (claim 14). By replacing a limitation of a parent claim, the child claim (13 or 14) no longer includes every limitation of the parent claim and is thus not a proper dependent claim. For more details, refer to MPEP section 608.01(n).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims **12-14** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim **12**, the limitation “for every ID specifying a telephone” on line 11 is indefinite; it is unclear what this limitation is claiming. Note that if this limitation is deleted from the claim, something will need to be added to give proper antecedent basis the limitations “said ID” in the rest of the claim.

Regarding claim **12**, the limitation “said ID is common to telephones” on line 10 is indefinite; it is not clear what this limitation means. For example, this limitation could mean that the ID is common to/used by multiple telephones and is not a unique identifier. (This interpretation would be inconsistent with the limitation that the ID includes the extension of the telephone, which would make it distinct for different telephones.) It could also mean that an ID is used for telephones and not other devices. This limitation must be reworded to more clearly indicate the subject matter the Applicant intends to claim.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims **1-3 and 6-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,393,017 to Galvin et al in view of RFC 1531 to Droms.

Regarding claims **1 and 10**, Galvin discloses a telephone controller controlling a plurality of telephones (data devices 102, 104 of Figure 1) connected to the Internet via a LAN (Local Area Network), said telephone controller (the virtual PBX system 100 of Figure 1) allowing an external telephone connected to the Internet to make a direct call to a telephone in the LAN comprising (see figure 9 for example): a memory (object storage data base 110 of Figure 1) in which a table (the combination of the tables in Figures 2-4) indicating a correspondence between IDs (Identifier) of the plurality of telephones (alias 202) and the private IP addresses (address

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406) is stored; and a control circuit which controls communication between the plurality of telephones and the Internet using the private IP addresses (processor 108 of Figure 1), wherein the ID includes a domain name of said telephone controller (see Figure 2 and line 40 of column 6) and identification information composed of a user name (clearly part of the email address referred to in line 40 of column 6) and an extension telephone number of the telephone (see lines 41-42 of column 6 which indicates that this id can be composed of any alphanumeric combination including telephone numbers and user names as indicated in the email address) and wherein said memory further stores therein a table indicating a correspondence among the ID, a private IP address, an extension telephone number, and a user name (this correspondence is clearly provided for in the combined table of figures 2-4), and wherein said control circuit extracts the identification information from an ID received via the Internet, searches said table with the identification information to obtain the private IP address (804 of Figure 8; implicit that the identification information is extracted as it is used to look up the user's network address), and executes communication between a telephone to which the private IP address is allocated and the Internet (806 of Figure 8). Further regarding claim 10, Galvin discloses the limitation that each of said plurality of telephones includes an input circuit which receives the ID and the identification information and sends the ID and the identification information received from said input circuit to said telephone controllers, said control circuit extracts the identification information from the ID received via the Internet, searches said table with the identification information to obtain the private IP address (804 of Figure 8; implicit that the identification information is extracted as it is used to look up the user's network address), and executes

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communication between a telephone to which the private IP address is allocated and the Internet (806 of Figure 8).

Galvin does not disclose expressly an IP (Internet Protocol) address allocating circuit which allocates a private IP address to each of the plurality of telephones. Galvin also does not disclose expressly the limitation that the correspondence between the IDs and the private IP addresses is stored in a single table.

However, Galvin indicates in lines 50-62 of column 7 that many variations of the organization of information shown in figures 2-4 could be used. At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine tables 2-4 into 1 table. The motivation for doing so would have been to reduce the memory required for this information; there are a number of fields that are duplicated in all three tables.

RFC 1531 discloses a commonly used protocol for automatically configuring hosts with IP addresses among other parameters (described throughout – see the abstract on page 1 for example). This discloses the limitation of the address allocating circuit which allocates a private IP address to each of the plurality of telephones. Galvin and RFC 1531 are analogous art because they are from the same field of endeavor of IP networking. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Galvin to use DHCP to automatically configure data devices 102 and 104. The motivation for doing so would have been to allow hosts to discover local configuration parameters without manual configuration as disclosed by RFC 1531 in the first paragraph of page 7. Therefore, it would have been obvious to combine RFC 1531 with Galvin for the benefit of automatically configuring hosts without manual configuration to obtain the invention as specified in claims 1 and 11.

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Regarding claim 3, Galvin, modified, discloses the limitations of parent claim 1 as discussed above. Galvin does not disclose expressly the limitation that the control circuit notifies the allocated IP address to the telephone. At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the DHCP server in the processor 108 of Figure 1. The motivation for doing so would have been to reduce costs by not requiring additional hardware equipment to add this feature.

Regarding claim 6, Galvin discloses the limitation that the memory further stores therein a table indicating communication history information for each ID in the billing information of lines 49-53 of column 4.

Regarding claim 7, Galvin discloses the limitation that the table is updated in response to a request from the telephone in lines 35-39 of column 7.

Regarding claim 8, Galvin discloses the limitation of the telephone controller further comprising means for receiving the ID, wherein said control circuit stores the ID received from said means for receiving into said memory in lines 35-39 of column 7.

Regarding claim 9, Galvin discloses the limitation of the transfer circuit which transfers information stored in said table to some other telephone controller in the function of controlling redundancy by the processor(s) 108 described in line 47 of column 4.

Allowable Subject Matter

3. Claim 12 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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4. The following is a statement of reasons for the indication of allowable subject matter: U.S. Patent 6,393,017 to Galvin et al and RFC 1531 to Droms are the closest prior art documents to claim 12. However, these documents do not disclose the limitations that (a) the ID includes identification data and a global domain name registered on the Internet, and the identification data of said ID includes a user identification section and an extension telephone number identification section for said extension telephone number of said telephone, and (b) that said registration request message includes said ID, in combination with the other limitations of claim 12.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Scheibel whose telephone number is 571-272-3169. The examiner can normally be reached on Monday and Thursday from 6:30-5:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LCS 2-2-06

Robert C. Scheibel
Examiner
Art Unit 2666

Tommin

DANG TON
PRIMARY EXAMINER